



Attorney's Docket No. J-2625A

PATENT

#4
WF
10/21/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Mark S. Wdowik

Serial No: 0 8 / 778,110 Group No.: 1207
Filed: December 21, 1996 Examiner: T. Mosley
For: Shaving Compositions Containing Particulate Additives

☐ *Patent No.: Issue Date:

*NOTE: Preferably also insert inventor's name and invention title.

Assistant Commissioner for Patents
Washington, D.C. 20231

TERMINAL DISCLAIMER TO OBVIATE
A DOUBLE PATENTING REJECTION (37 CFR 1.321(c))

Identification of Person(s) Making This Disclaimer

J. William Frank, III

I, _____
(type or print names of all inventors or assigns or name of attorney signing disclaimer)

(a) represent that I am

- ☐ an inventor of this invention.
☐ an assignee of this invention.

WARNING: "If the patent or patent application is assigned to an organization, such as a corporation, partnership, university, [g]overnment agency or similar entity, and the disclaimer is signed by the assignee, the assignee must comply with § 3.73(b)." Notice of Oct. 15, 1993, 1156 O.G. 54-61 at 56.

- ☐ a representative authorized to sign on behalf of the assignee identified below.
☐ A certification under 37 C.F.R. 3.73(b) is attached.

WARNING: See the above "WARNING".

☒ the attorney of record for this invention.

NOTE: The rules "permit an attorney or agent of record to sign a terminal disclaimer without the need to comply with § 3.73(b)." Notice of Oct. 15, 1993, 1156 O.G. 54-61, at 56.

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office.

Karen L. Rahm
Signature

Karen L. Rahm
(type or print name of person certifying)

10/06/1997 DFLOYD Date: 10/18/97 00000030 DAH:100849 08778110
Sale Ref: 00000085 DAH: 100849 08778110
01 FC:148 110.00 CH

(Terminal Disclaimer to Obviate a Double Patenting Rejection [9-4]—page 1 of 4)

IDENTITY OF ASSIGNEE AND TITLE OF DISCLAIMER
(if applicable)

The assignee is

Name of assignee S. C. Johnson & Son, Inc.

Address of assignee 1525 Howe Street, M.S. 077

Racine, Wisconsin 53403-2236

Title of disclaimant authorized to sign on behalf of assignee _____

EXTENT OF DISCLAIMER'S INTEREST

The extent of the interest in this invention that the disclaimant owns is in:

☒ the whole of this invention.

☐ a sectional interest in this invention, as follows:

(state the exact interest of the disclaimant)

RECORDAL OF ASSIGNMENT IN PTO
(if applicable)

☒ The assignment was recorded on 06/13/1997

Reel 8554

Frame 0302

☐ Authorization for recordal of the assignment is separately attached.

☐ A separate ☐ "ASSIGNMENT (DOCUMENT) COVER SHEET" or
☐ FORM PTO 1595 is also attached.

ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION
(if applicable)

☐ Attached is a CERTIFICATE UNDER 37 CFR 3.73(b) establishing the right of the assignee to take action in this case.

DISCLAIMER

The terminal part of the statutory term of any patent granted on the above-identified application or the above-identified patent that is subject to re-examination, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 of the patent or application forming the basis of the double patenting rejection.

☒ United States Patent No. 5,587,156, as presently shortened by any terminal disclaimer,

☐ Any patent granted on application number
0 / _____,

is hereby disclaimed, except as provided below, and it is agreed that any patent so granted on the above-identified application shall be enforceable only for, and during, such period that the legal title to said patent shall be the same as the legal title to

☒ United States Patent No. 5,587,156

☐ Any patent granted on application number
0 / _____,

this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the patent or application forming the basis of the double patenting rejection.

☒ United States Patent No. 5,587,156, as presently shortened by any terminal disclaimer,

☐ Any patent granted on application number
0 / _____

in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued in any matter or is terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

FEE STATUS

(37 CFR 1.20(d))

☒ Other than a small entity—fee \$110.00.

☐ Small entity—fee \$55.00.

☐ A verified statement is attached.

☐ A verified statement was already filed on _____.

FEE PAYMENT

- ☐ Attached is a check in the sum of \$_____.
- ☐ Charge Account _____ for any fee deficiency.
- ☒ Charge Deposit Account 10-0849 the sum of \$110.00.
- A duplicate of this disclaimer is attached.

DECLARATION

- ☐ As I am not a person registered to practice before the Office, I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under SECTION 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: September 18, 1997

Reg. No.: 25,636

Signature of disclaimant



SIGNATURE OF ATTORNEY OF RECORD

J. William Frank, III

(type or print name of attorney)

S. C. Johnson & Son, Inc.

1525 Howe Street, MS 077

P.O. Address

Racine, Wisconsin 53403-2236

(Terminal Disclaimer to Obviate a Double Patenting Rejection [9-4]—page 4 of 4)

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 10/21/97
TO EXAMINER: Mosley
PARALEGAL: Nathanya Ferguson - 6A16

APPL. S.N. 08, 778/110
ART UNIT: 1207
MAILROOM DATE 9/22/97

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL; INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)